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PATENT
DKT. HO-P02393US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	**Timothy E. Grib and Michael A. Brown**	
Assignee:	**WILTEL COMMUNICATIONS GROUP, INC.**	
Application No.:	**09/964,232**	Group Art Unit: **2143**
Filed:	**September 26, 2001**	Examiner: **Kyung H. Shin**
For:	**METHOD AND APPARATUS FOR PERFORMANCE MEASUREMENT OF DIFFERENT NETWORK ROUTES BETWEEN DEVICES**	

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

ACCOMPANYING ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper constitutes accompanying arguments for a pre-appeal brief request for review for the above identified U.S. patent application. A Notice of Appeal and a Pre-Appeal Brief Request for Review have been filed herewith. In addition to the below Pre-Appeal, the Applicant encourages the Pre-Appeal Panel to review the Applicants response to final.

Present Status of Claims

Claims 1-29 are pending in the application. Of these claims:

1. Claims 1-9, 13, and 15-29 stand finally rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,763,380 issued to Mayton et al., (Mayton).
2. Claims 10-12 and 14 stand finally rejected under 35 U.S.C.§103(a) as being obvious over Mayton in view of United States Patent No. 6,360,268 issued to Stephen Silva et al., (Silva).

No post-final amendments have been provided to the claims.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
I hereby certify that, on the date shown below, this correspondence is being:

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Date: February 19, 2007

Tiffany Koch
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Claim Language at Issue

Independent claims 1, 15, and 16 recite *inter alia*, "the first and the second performance tests are performed ***simultaneously***." (Emphasis Added). Independent claim 21 recites *inter alia*, "a performance test is conducted between the first device and the second device over each of the first and second transport networks ***simultaneously***." (Emphasis Added).

The above emphasized language of claims 1, 15, 16, and 21 are generally at issue with regard to the §102 rejections.

Summary of Arguments in Favor of Patentability

The Applicant respectfully submits that the case is not ripe for appeal on the basis of clear legal and factual errors on the part of the Examiner. This can be readily demonstrated by the following points.

1. The Examiner has sustained the final rejection under 35 U.S.C. §102, despite the fact that every limitation of the independent claims has not been found in a single prior art reference.

a. The legal test for anticipation of a claim is that every limitation of the claim must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286 (Fed. Cir. 2001). *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002).

b. Independent claims 1, 15, 16, and 21 recite simultaneous testing. In contrast, the Examiner stated "performance tests completed utilizing an extremely short time period are considered to be simultaneous, and that the tests are performed essentially simultaneously." Final Office Action pg. 4, lines 1-3 (emphasis added).

c. Contrary to the Examiner's position, periodic or essentially simultaneous testing does not anticipate simultaneous testing. The language of Mayton cited by the Examiner specifically states that network performance measurements (tests) may be obtained **on a repeated basis**. A repeated basis requires a period of time to pass between the test measurements. Thus the measurements disclosed in Mayton are, at best, sequential tests and therefore are not simultaneous tests.

d. As a result, the Examiner has failed to correctly apply the applicable law in the present case because not every element is shown in a single reference. Thus, a *prima facie* case of anticipation has not been established and the final rejection under §102 is accordingly without merit and constitutes reversible error.

2. The Examiner has further sustained the final rejection under 35 U.S.C. §102, through improper hindsight reasoning.

a. The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

b. The Examiner stated "performance tests completed utilizing user initiation can be performed essentially simultaneously, since initiation can be performed simultaneously." Final Office Action pg. 4, lines 3-5.

c. There is no support within the four corners of the Mayton reference that a user would initiate a non-scheduled performance test simultaneously with either an active, passive, or scheduled test because it would defeat the purpose of the Mayton invention to initiate a secondary test simultaneously with a first test. The tests run in Mayton are designed to measure the time it takes a signal to traverse a single given path, then to compare that result against a previously measured baseline time value for that single given path. To initiate two tests simultaneously to check against a baseline time value for the single given path would lead to redundant testing. Thus, there is no rationale, absent the impermissible reasoning by the Examiner, for a user to initiate a non-scheduled test simultaneously with a second test for the identical, single given path.

d. Therefore, there is no teaching in Mayton which anticipates the limitations of claims 1, 15, 16, and 21 absent the hindsight reasoning employed by the Examiner in crafting the hypothetical actions of a user initiating a non-scheduled test simultaneously with a second test for the identical path. Therefore, a *prima facie* case of anticipation has not been established and the final rejection under §102 is accordingly without merit and constitutes reversible error.

3. The Examiner sustained the final rejection under 35 U.S.C. §102 based on a misplaced technical characterization of the application.

a. The Examiner stated, in a section completely devoid of any citation to a teaching in the prior art of record, that "A computer system with a processor can only execute one instruction at a time. Therefore, a computer can [only] do one action at a time. It is not possible to start two tests at the same instantaneous point in time...from a human perspective it appears that a computer system can perform multiple actions at the same time. In actuality, only one action at a time can be performed." *See* Final Office pg. 3, lines 4-9.

b. Current claims 1, 15, 16, and 21 do not recite a processor that performs a plurality of actions at one time. Instead, what is claimed is that **tests** are performed simultaneously. Ample support for this claim language exists in the specification. *See* Response to Final Office Action pg. 9, lines 6-20.

c. The Applicant respectfully submits that in light of the disclosure in the application of simultaneous testing, the Examiner either fails to understand the art, or is mischaracterizing the claim language in suggesting that only one action at a time can be performed. This error leads the Examiner to the faulty conclusion that since tests can't be performed simultaneously, any tests disclosed in Mayton that run during an extremely short time period or are performed essentially simultaneously must be analogous to the claimed simultaneous testing in claims 1, 15, 16, and 21.

d. Since the Applicants disclose ample support for simultaneous testing, it is inappropriate not to give the claim language its plain meaning, and further to conclude that "only one action at a time can be performed." Moreover, it was improper to use this faulty conclusion as support for the proposition that essentially simultaneous tests are analogous to simultaneous tests. Therefore, absent this mischaracterization of the application, a *prima facie* case of anticipation has not been established and the final rejection under §102 is accordingly without merit and constitutes reversible error.

Conclusion

The case is not ripe for appeal as the final rejection is without basis on the following grounds:

1. Clear legal error exists with regard to the failure of the Examiner to find every limitation of the independent claims in a single prior art reference.
2. Clear legal error exists with regard to the improper use of hindsight reasoning by the Examiner.
3. Clear legal and factual error exists based on a misplaced technical characterization of the application.

Reconsideration of the final rejection and allowance of all pending claims 1-29 is therefore respectfully solicited.

Respectfully submitted,

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